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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Norman Ken Ouchi

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02/05/2007

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EXAMINER

ADE, OGER GARCIA

ART UNIT

PAPER NUMBER

3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/939,453	Applicant(s) OUCHI, NORMAN KEN	
	Examiner Garcia Ade	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-49 is/are pending in the application.
- 4a) Of the above claim(s) 36 - 42, 50 - 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II, claims 43 - 49 in the reply filed on November 8th, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 36 - 42, 50 - 55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Groups I and III, there being no allowable generic or linking claim.

Claim Objections

3. The claims are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 C.F.R. §1.52(b).

Double Patenting

4. Claims 43 - 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 15 of U.S. Patent No. 6,687,557. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the same invention.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 43 - 49 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test:

- (1) The invention must be within the technological arts; and
- (2) The invention must produce a useful, concrete, and tangible result.

7. In this case, the claims do not produce a useful, concrete, and tangible result. If Applicant's specification supports such an amendment, the Examiner recommends, by way of example only, that Applicant recite that 'outputting the translation to a device' such as a computer monitor or printer.

Claim Rejections - 35 USC §112 2nd Paragraph

8. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 43 - 49 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Some examples follow.

- a. The phrase "translate and validate" in the body does not make grammatical sense. Additionally, it is unclear if Applicant is using indents to help interpret the claims.

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- b. Claims 44 - 46 recite the limitation "translation" respectively. There is insufficient antecedent basis for this limitation in the claim.
10. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 43 - 49, as best understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. [US 6,324,522], and further in view of Mantripragada et al. [US 7,127,458].

As per claims 43 - 48, Peterson discloses a system with a first catalog and a second catalog [see inventory networks section of the invention (e.g. search by catalog number may be performed)] to translate and validate a first product description document [via step 178 (e.g. description of the item)]; with an item identifier from a first set of item

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identifiers, including part numbers or supplier names or supplier nicknames [see inventory networks section, via Universal Product Code (UPC) code number, a unique identifying number assigned to a manufacturer's product]; to a second product description document with an item identifier from a second set for a first site where: the first catalog provides a translation of the item identifier from the first set to an item identifier from a third set [see flowchart of figure 8, via step 197]; using the first catalog, the first product description document with the item identifier from the first set is translated to a third product description document with the item identifier from the third set [see flowchart of figure 9, via step 220]; the second catalog provides for the first site, a translation of the item identifier from the third set to the item identifier from the second set; using the second catalog, the third product description document with the item identifier from the third set is translated to the second product description with the item identifier from the second set for the first site [see flowchart of figure 9A, via look-up table, steps 250 and 252].

Peterson does not explicitly disclose an approved manufacturer list. However, Mantripragada discloses an approved manufacturer list [see flowchart of figure 5 (e.g. block 160), column 3, lines 52 – 67, and column 4, lines 39 – 44].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Peterson to include the approved manufacturer list of Mantripragada. The motivation to combine would provide a faster and more efficient technique for matching part

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information in an input BOM file to one or more known sources of parts data [see summary of the invention].

As per claim 49, Peterson discloses the first catalog provides a translation of an item identifier from the first set to a commodity item identifier where the first product description document with the item identifier from the first set is translated to a third product description document with the commodity item identifier [see column 20, lines 27 – 54 (e.g. a **commodity code number** may also be provided by a trade group a **commodity code** is a code assigned to all items of the same type, regardless of the manufacturer)].

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571.272.6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade
Examiner
Art Unit 3627

ga

Andrew Joseph Rudy
Primary Examiner, AU 3627